

REMARKS

Claims 1 – 21 and 23 – 26 remain in the application and stand finally rejected. A proposed amendment amending claims 1, 2, 7, 8 and 10 is offered herein. Claim 18 is previously canceled. No new matter is added. Although this Amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

The specification is amended grammatically by this proposed amendment. No new matter is added.

Although claim 22 is listed in the Office Action Summary as finally rejected, nothing in either the first Office action or the final Office action indicates with any specificity ANY basis for rejecting claim 22. Therefore, claim 22 is deemed objected to for depending from a rejected base claim, but would be allowable if rewritten in independent form.

Claims 3, 4, 6, 12 – 14, 18 – 21 and 26 are finally rejected as being non-enabled, i.e., failing the enablement requirement of 35 U.S.C. §112 second paragraph. Neither the previous nor the final Office action indicates anything specific with respect to rejected claims 3, 4, 6, 12 – 14, 18 – 21 and 26. Both, instead, assert that the Drawings fail to enable the claims. MPEP §2143.03 provides in pertinent part

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

INDEFINITE LIMITATIONS MUST BE CONSIDERED

A claim limitation which is considered indefinite **cannot be disregarded**. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see MPEP §706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222USPQ 537 (Bd. Pat. App. & Inter. 1984) (Claims on appeal were **rejected on indefiniteness grounds only**; the rejection was reversed and the case remanded to the examiner for consideration of pertinent prior art.). Compare *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious) and *In*

re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

LIMITATIONS WHICH DO NOT FIND SUPPORT IN THE ORIGINAL SPECIFICATION MUST BE CONSIDERED

When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims **must be considered** and given weight, including limitations which do not find support in the specification as originally filed (i.e., new matter). *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.* 738 F.2d 453 (Fed. Cir. 1984) (Claim to a catalyst expressly excluded the presence of sulfur, halogen, uranium, and a combination of vanadium and phosphorous. Although the negative limitations excluding these elements did not appear in the specification as filed, it was error to disregard these limitations when determining whether the claimed invention would have been obvious in view of the prior art.).

(emphasis added). As set forth below, the applicants believe that the SPECIFICATION, as filed provides adequate support to a skilled artisan to make and use the invention. Since both the initial rejection and final rejection of claims 3 – 4, 6, 12 – 14, 19 – 21 and 26 are non-substantive, it is respectfully submitted that no substantive rejection has been made of independent claim 26 and/or dependent claims 3 – 4, 6, 12 – 14, and 19 – 21.

Therefore, independent claim 26 has not yet been examined; and, therefore, it is respectfully submitted that the final rejection, at least with respect to claim 26, which has never been substantively examined or rejected, is improper. Moreover, either the dependent claims 3 – 4, 6, 12 – 14, and 19 – 21 have not been examined or, otherwise, are deemed objected to for depending from a rejected base claim, but would be allowable if rewritten in independent form. Accordingly, it is respectfully submitted that the final rejection with respect to claims 3 – 4, 6, 12 – 14, and 18 – 21, which also have never been substantively examined or rejected, is improper and must be withdrawn.

In finally rejecting claims 3 – 4, 6, 12 – 14, 19 – 21 and 26 for lack of enablement, the final Office action repeats the assertion that “the Applicant vaguely discloses in the Specification on page 5 lines 5 – 9 where a fake call control connection is originated in parallel to the said MT-LR request, no representation is indicated **in the referenced figures**; thus, hampering one of ordinary skill in the art to clearly interpret the Applicant’s claimed language.” Final Office action, page 2 (emphasis added). In responding to the applicants’ suggestion to look to the

description of Figures 2A – B in the succeeding (to page 5) 3 pages; the final Office action responds “that the claimed invention ‘faked call control’ is not supported by the Specification or Drawings” and that “[f]urther, although stated by the Applicant that the information is rendered in the Drawings, nowhere in any of the **drawings does the phraseology appear.**” Response to Arguments, page 10 (emphasis added). MPEP § 608.02(I) provides in pertinent part that “[t]he lack of a drawing in this situation [i.e., where such drawing is necessary for the understanding of the invention] does not render the application incomplete but rather is treated as an informality.” However, as previously pointed out, there is no requirement that any phraseology, much less “faked call control,” appear in the drawings. Further, as was also previously pointed out and as set forth hereinbelow, the applicants believe the application to be sufficiently enabling as filed and believe that the features of the claims are sufficiently represented in the drawings.

The Federal Circuit has provided that if “the meaning of the claim is discernable, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds.” *Exxon Research and Engineering Co. v. United States*, 265 F.3d 1371, 1375, 60 U.S.P.Q.2d 1272 (Fed. Cir. 2001). Furthermore, the Federal Circuit has long required that

When rejecting a claim under the enablement requirement of section 112, **the PTO bears an initial burden of setting forth a reasonable explanation** as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. If the PTO meets this burden, the burden then shifts to the applicant to provide suitable proofs indicating that the specification is indeed enabling.

In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (emphasis added). It is respectfully submitted that this burden has not been met. Additionally,

There is no requirement in 35 U.S.C. § 112 or anywhere else in the patent law that a specification convince persons skilled in the art that the assertions in the specification are correct. . . . In examining a patent application, **the P.T.O. is required to assume that the specification complies with the enablement** provision of Section 112 unless it has ‘acceptable evidence or reasoning’ to suggest otherwise. . . . The P.T.O. thus **must provide reasons** supported by the record as a whole why the specification is not enabling. . . . Then and only then

does the burden shift to the applicant to show that one of ordinary skill in the art could have practiced the claimed invention without undue experimentation.

Staehelin v. Secher, 24 USPQ2d 1513 (Bd. Pat. App. & Int’f 1992) (emphasis added).

However, “undue experimentation” was not the standard applied in either of the first Office action or the final Office action. Instead, the rejection is based on an assertion that “no representation is indicated in the referenced figures; thus, **hampering one of ordinary skill in the art** to clearly interpret the Applicants claimed language.”

Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations. . . .

Factors to be considered in determining whether a disclosure would require undue experimentation . . . include

- (1) the quantity of experimentation necessary,
- (2) the amount of direction or guidance presented,
- (3) the presence or absence of working examples,
- (4) the nature of the invention,
- (5) the state of the prior art,
- (6) the relative skill of those in the art,
- (7) the predictability or unpredictability of the art, and
- (8) the breadth of the claims.

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400 (Fed. Cir. 1988). It is respectfully submitted that there is no indication in anything of record that any of the *Wands* factors were weighed to arrive at a reasoned conclusion. Accordingly, since no suitable basis to support finding not just that “one of ordinary skill in the art [is hampered from] clearly [interpreting] the Applicants claimed language;” but “that one of ordinary skill in the art could have practiced the claimed invention without undue experimentation” has been provided, the rejection under 35 U.S.C. § 112 for non-enablement cannot stand.

Moreover, the applicants continue to assert that the application as filed is enabling. As previously indicated, with reference to Figure 2A and the corresponding description starting on page 5, the application provides in pertinent part that

A faked CC connection begins in 158 with the MSC 116 sending a **dummy or fake register message 158** to the MS 106 using Direct Transfer Application Part (DTAP) application protocol. The MS 106 ignores or rejects the fake or dummy

register message 158, but as side effect, it can process the MO request in 160 with a connection management (CM) service request from the MS 106 to the BSC 114.

Page 6, lines 20-25 (emphasis added). Thus, clearly, a dummy or faked call control (faked CC) connection (as recited in claims 3, 12, 19 and 26) is supported by the Specification and Figure 2A. The content of the dummy or faked CC connection is unimportant, as its purpose is to elicit the response, i.e., that the “MS 106 ignores or rejects the fake or dummy register message 158, [and] as side effect, ... [processes] the MO request in 160 with a connection management (CM) service request from the MS 106 to the BSC 114.” *Id.* Furthermore, with reference to “Figure 2B, in **172 a faked RRLP request** to the MS 106 originates in the BSC or SMLC 174 after perform location request 156.” *Id.*, lines 33 – 34. Thus, clearly, a dummy or faked radio resource location protocol (RRLP) request (as recited in claims 4, 6, 13, 14, 20 and 21) is supported by the Specification and Figure 2B. Therefore, the recitations of the claims are supported by the Specification and drawings, the rejection of claims 3 – 4, 6, 12 – 14, 19 – 21 and 26 is improper and must be withdrawn. Accordingly, because the burden has not been met to establish non-enablement and because, as set forth hereinabove, adequate enablement is provided by the specification and drawings, reconsideration and withdrawal of the final rejection under 35 U.S.C. §112 and, further, allowance of these unexamined/objected to claims 3 – 4, 6, 12 – 14, 19 – 21 and 26 is respectfully requested.

Claims 1, 2, 5, 7 – 10 and 15 are finally rejected under 35 U.S.C. §102(e) as being unpatentable over published U.S. Patent Application No. 2005/0043041 A1 to Ignatius et al. Claims 16, 17 and 23 – 25 are finally rejected under 35 U.S.C. §102(b) as being unpatentable over *Digital Cellular Telecommunications Systems (GSM)*; *Universal Mobile Telecommunications System (UMTS)*; *Functional Stage 2 Description of Location Services* (the 3GPP specification). Claim 11 is finally rejected 35 U.S.C. §103(a) as being unpatentable over Ignatius et al. in view of 3GPP.

Regarding the final rejection of claims 1, 2, 5, 7 – 10 and 15, it is asserted that Ignatius et al. teaches the present invention, with specific reference to paragraphs 0007, 0040, 0041, 0042, 0044, 0047, 0052 and 0061. The final Office action responds to arguments regarding claim 2 in the previous amendment that “[n]owhere in the claim does it state that the actions are

simultaneous;” Claim 1 is amended by this proposed amendment to recite “a request for services from one MS unit of said plurality of MS units is not placed on hold while an ongoing LCS request to said one MS unit completes.” This is neither taught nor suggested by any reference of record. This amendment to claim 1 (with a similar amendment to claim 10) is supported in the specification as originally filed and by claim 16. No new matter is added. Therefore, Ignatius et al. neither teaches or suggests the present invention as recited in claims 1 and 10 as amended. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1 and 10 is respectfully requested.

Furthermore, because dependent claims include any differences with the prior art as the claims from which they depend, dependent claims 2, 5, 7 – 9 and 15, which depend from claims 1 and 10, are patentable over Ignatius et al., alone or in combination with any reference of record. Claims 2, 7 and 8 are amended by this proposed amendment. No new matter is added. The applicants respectfully request entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1, 2, 5, 7 – 10 and 15 under 35 U.S.C. §102(e) over Ignatius et al.

In responding to applicant’s arguments regarding the rejection of claims 16, 17 and 23 – 25 over the 3GPP specification, the final Office Action asserts “that the cited prior art clearly renders sufficient support of the claimed language and therefore the rejection stands.” However, the “present invention overcomes a **heretofore unknown shortcoming** within the current wireless network standards [e.g., the 3GPP specification] that forces a MS to wait until the prior MT-LR (started in idle mode) completes, placing the MS on hold for any Mobile Originating (MO) transactions, e.g., an Emergency Call.” Page 3, lines 24-28 (emphasis added). As previously noted, even if each of the steps recited by claim 16 is independently disclosed by the 3GPP specification; that the individual steps are each taught by the 3GPP specification is insufficient to find anticipation. A collection of steps is insufficient to show the identical invention in as complete detail as is contained in claim 16. The steps are not taught by the 3GPP specification as arranged as required by claim 16. There is no indication of any awareness of the above shortcoming in for the 3GPP specification and, indeed there was none prior to the present invention. Therefore, as was previously pointed out, both in the specification and the previous response, the 3GPP specification fails to teach MO transactions being allowed to originate (claim

16 step (c)) and process (step (d)) even in the presence of an ongoing MT-LR that initiates in step (a) and receives a response in step (e). Thus, communications according to the 3GPP specification fail to perform “the identical function specified in the claim[s] in substantially the same way,” and do not produce “substantially the same results as the corresponding element disclosed in the specification.” MPEP at §2184. Therefore, the 3GPP specification fails to teach the present invention as recited in claim 16. The applicants respectfully request reconsideration and withdrawal of the final rejection of claim 16 under 35 U.S.C. §102(b) over the 3GPP specification.

Furthermore, because dependent claims include any differences with the prior art as the claims from which they depend, dependent claims 17 and 23 – 25, which depend from claim 16, are patentable over the 3GPP specification, alone or further in combination with any reference of record. The applicants respectfully request reconsideration and withdrawal of the final rejection of claims 17 and 23 – 25 under 35 U.S.C. §102(b) over the 3GPP specification.

Regarding the final rejection of Claim 11 under 35 U.S.C. §103(a) over the combination of Ignatius et al. and the 3GPP specification, in addition to the fact that claim 11 depends from claim 10 and so, is also patentable for the reasons that claim 10 is patentable; Ignatius et al. and the 3GPP specification add nothing to each other to overcome the shortfall of each. So, the combination of both references still does not result in the present invention as recited in claim 11. The applicants respectfully request reconsideration and withdrawal of the final rejection of claim 11 under 35 U.S.C. §103(a) over Ignatius et al. in combination with the 3GPP specification.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request that the Examiner enter the proposed amendment, reconsider and withdraw the final rejection of claims 1 – 17, 19 – 21 and 23 – 26 under 35 U.S.C. §§102(b), (c), 103(a) and 112 and allow the application to issue.

The applicants note that MPEP §706 "Rejection of Claims," subsection III, "PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED" provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been **disclosed** and the record indicates that the applicant **intends to claim** such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.

(emphasis added.) The applicants believe that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

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